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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/935,396
Filing Date: August 23, 2001
Appellant(s): GUSLER ET AL.

Robert C. Rolnik
(Reg. No. 37,995)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 27, 2009 appealing from the Office action mailed February 11, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is partly correct. New grounds of rejection have been rendered with respect to claims 9-15 under 35 USC 112 2nd paragraph.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,901,372	Helzerman	5-2005
20070288292	Gauger	12-2007

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 112

1. Claims **9-15** are rejected under 35 USC § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim(s) recites/recite the following means (or step) plus function limitation:

Claim 9
- means for determining at least one decision maker of a project preparation;
- means for determining a readiness category for the decision maker;
- means for providing a readiness category rating for the readiness category;
- means for determining a decision process for the readiness category and readiness category rating;
- means for conducting a project assessment as a function of the decision process;
- means for determining a project readiness as a function of the project assessments.

Claim 10
- means for assigning vote weighting to the decision maker.

Claim 11
- means for changing a project management application graphical interface, as a function of the project assessment.

Claim 12
- means for assigning a time limit in association with the project assessment and the project readiness.

Claim 13
- means for providing a collaborative environment for the decision maker.

Claim 14
- means for providing project information from a project creator;
- means for accessing a data repository;
- means for retrieving a list from the data repository;

- means for selecting a project decision maker as a function of the project information and list; and
- means for selecting at least one contributing decision maker as a function of the project information, list and project decision maker.

Claim 15

- means for providing technical information from the project creator; and
- means for providing security information from the project creator.

This limitation invokes 35 USC § 112, ¶ 6 because it meets the 3-prong analysis set forth in MPEP 2181 as it recites the phrase "means for" or "step for" (or appellant identifies the limitation as a means (or step) plus function limitation in the appeal brief) and the phrase is modified by functional language and it is not modified by sufficient structure, material, or acts for performing the recited function. Also see *Altiris Inc. v. Semantec Corp.*, 318 F.3d 1363, 1375 (Fed. Cir. 2003). 35 USC § 112, ¶ 6, requires such claim to be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. "If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section § 112." *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ 1845, 1850 (Fed. Cir. 1994)(in banc.). For a computer-implemented means-plus-function claim limitation that invokes 35 USC § 112, ¶ 6, the corresponding structure is required to be more than simply a general purpose computer. *Aristocrat Technologies, Inc. v. International Game Technology*, 521 F.3d 1328, 1333, 86 USPQ2d 1235, 1239-40 (Fed. Cir. 2008). The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer. *WMS Gaming,Inc. v. International Game Technology*, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999). The written description must at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the claimed function. *Aristocrat*, 521 F.3d at 1338, 86 USPQ2d at 1242.

In the instant application, the following portions of the specification and drawings may appear to describe the corresponding structure for performing the claimed function:

Claim 9

- means for determining at least one decision maker of a project preparation (Fig. 2, Block 220);
- means for determining a readiness category for the decision maker (Fig. 2, Block 230);
- means for providing a readiness category rating for the readiness category (Fig. 2, Block 230; Spec. 7:1-4);
- means for determining a decision process for the readiness category and readiness category rating (Spec. 7:11-18);
- means for conducting a project assessment as a function of the decision process (Fig. 2, Block 260; Spec. 8:20-27);

- means for determining a project readiness as a function of the project assessments (Fig. 2, Block 270; Spec. 2:21-22).

Claim 10
- means for assigning vote weighting to the decision maker (Fig. 2, Block 240; Spec. 7:11-25).

Claim 11
- means for changing a project management application graphical interface, as a function of the project assessment (Spec. 8: 13-27).

Claim 12
- means for assigning a time limit in association with the project assessment and the project readiness (Spec. 9-10)

Claim 13
- means for providing a collaborative environment for the decision maker (Fig. 2, Block 220; Spec. 5: 14-25).

Claim 14
- means for providing project information from a project creator (Spec. 5:23-6:20);
- means for accessing a data repository (Spec. 6: 12-20);
- means for retrieving a list from the data repository (Spec. 7: 28-29);
- means for selecting a project decision maker as a function of the project information and list (Spec. 13: 4-11); and
- means for selecting at least one contributing decision maker as a function of the project information, list and project decision maker (Fig. 3, Block 340).

Claim 15
- means for providing technical information from the project creator (Spec. 12: 21-26, Fig. 3, Block 330); and
- means for providing security information from the project creator (Fig. 3, Block 330).

However, the specification and drawings do not disclose sufficient corresponding structure, material or acts for performing the claimed function.

Claim 9 is directed to automated project accountability. No algorithm is disclosed showing the basis for determining a decision maker (Note: A person is not a means). The disclosure does not disclose any algorithm for determining a readiness category; for providing a readiness category, or a rating for the readiness category (no algorithm describes any rating); for determining a decision process for the readiness category and readiness category rating (no algorithm describes how to compute which weight to assign to voters, or how to collect vote data, etc.; for conducting a project assessment as a function of the decision process and for determining a project readiness as a function of the project assessments.

The disclosure does not describe any algorithm for assigning vote weighting in claim 10. While a simple majority is described, no algorithm describes the basis for assigning weights.

The disclosure does not describe any algorithms to support changing an interface as a function of any assessment, or how an assessment occurs in claim 11. While an icon is described, no algorithm describes the functions noted.

Similar to the analysis above, the disclosure does not describe any algorithms to support the means functions recited in claims 12-15. While the particular results are described in some cases, such does not constitute an algorithm as to how to obtain the results.

Claim Rejections – 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims **1-8** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-8 recite purely mental steps and must be tied to another statutory class (the thing or product) to which is tied, for example by identifying the apparatus that accomplishes the method steps or positively recites the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. A process claim that does not involve a transformation must involve, or be tied to, another category of statutory subject matter (i.e., a machine, manufacture, or composition of matter).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims **1-8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Frye et al (hereinafter, "Frye", U.S. Pub. No. 2001/0032105) in view of Helzerman (U.S. Pat. No. 6,901,372) and in further view of Gauger (U.S. Pub. No. 2007/0288292).

As per claim **1**, Frye discloses a method, system and computer readable medium for automated project accountability comprising:

- determining at least one decision maker of a project preparation (abstract and paragraph 0030);
- determining a project readiness as a function of the project assessments (paragraphs 0034 and 0040).
- providing a readiness category rating for the readiness category (paragraph 0040);
- conducting a project assessment as a function of the decision process (paragraphs 0034 and 0040).

However, Frye does not explicitly disclose:

- determining a readiness category for the decision maker; and
- determining a decision process for the readiness category and readiness category rating.

Helzerman discloses a quality operation system for performing manufacturing projects comprising:

- determining a readiness category for the decision maker (col. 4, lines 41-64); and
- determining a decision process for the readiness category and readiness category rating (col. 3, lines 25-53 and col. 6, lines 22-49).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Frye by incorporating or implementing a quality operating system for developing and conducting concept feasibility and ready phases for a desired product to ensure that the manufacturing project is completed in a timely and efficient manner.

While the combined system of Frye and Helzerman substantially discloses a method for automated project accountability, it does not explicitly disclose an electronic forum. Nonetheless, an electronic forum is well known in the art as evidence by Gauger.

In a similar art, Gauger discloses a network based interactive project management apparatus and method comprising an electronic forum (paragraphs 0196-0198, Gauger discloses a collaboration center which is used by key individuals to hold meetings, solve team problems and allow threaded discussions).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Frye in view of Helzerman to incorporate or implement an electronic forum for the purpose of allowing key individuals of a project to discuss and solve problems in a timely and efficient manner.

As per claim **2**, Frye discloses the invention substantially as claims discussed above.

However, Frye does not explicitly disclose:

- assigning vote weighting to the decision maker.

Helzerman discloses a quality operation system for performing manufacturing projects comprising:

- assigning vote weighting to the decision maker (col. 2, lines 48-63 and col. 4, lines 41-64); and

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Frye by incorporating or implementing a quality operating system for selecting and assigning members of technology group project assignments for a desired product to ensure that the manufacturing project is completed in a timely and efficient manner.

As per claim **3**, Frye discloses:

- changing a project management application graphical interface, as a function of the project assessment (paragraphs 0033 and 0034).

As per claim **4**, Frye discloses:

- assigning a time limit (milestones, dates, etc.) in association with the project assessment and the project readiness (paragraph 0025).

As per claim **5**, Frye discloses:

- providing a collaborative environment for the decision maker (paragraph 0031).

As per claim **6**, Frye discloses:

- wherein the collaborative discussion mechanism is invoked for determining the readiness category, determining the decision process, conducting the project assessment, and determining the project readiness (paragraph 0031).

As per claim **7**, Frye discloses wherein the determination of at least one decision maker further comprises:

- providing project information from a project creator; accessing a data repository; retrieving a list from the data repository; selecting a project decision maker as a function of the project information and list; and selecting at least one contributing decision maker as a function of the project information, list, and project decision maker (paragraphs

0031 and 0040, Frye discloses different stage approvers to review and decide whether the program (project) is ready to advance to the next stage).

As per claim **8**, Frye discloses:

- providing technical information from the project creator (paragraph 0030); and
- providing security information from the project creator (paragraph 0033).

5. Claims **9-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Frye et al (hereinafter, "Frye", U.S. Pub. No. 2001/0032105) in view of Helzerman (U.S. Pat. No. 6,901,372).

As per claims **9** and **16**, Frye discloses a method, system and computer readable medium for automated project accountability comprising:

- determining at least one decision maker of a project preparation (abstract and paragraph 0030);
- determining a project readiness as a function of the project assessments (paragraphs 0034 and 0040).
- providing a readiness category rating for the readiness category (paragraph 0040);
- conducting a project assessment as a function of the decision process (paragraphs 0034 and 0040).

However, Frye does not explicitly disclose:

- determining a readiness category for the decision maker; and
- determining a decision process for the readiness category and readiness category rating.

Helzerman discloses a quality operation system for performing manufacturing projects comprising:

- determining a readiness category for the decision maker (col. 4, lines 41-64); and
- determining a decision process for the readiness category and readiness category rating (col. 3, lines 25-53 and col. 6, lines 22-49).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Frye by incorporating or implementing a quality operating system for developing and conducting concept feasibility and ready phases for a desired product to ensure that the manufacturing project is completed in a timely and efficient manner.

As per claims **10** and **17**, Frye discloses the invention substantially as claims discussed above.

However, Frye does not explicitly disclose:

- assigning vote weighting to the decision maker.

Helzerman discloses a quality operation system for performing manufacturing projects comprising:

- assigning vote weighting to the decision maker (col. 2, lines 48-63 and col. 4, lines 41-64); and

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Frye by incorporating or implementing a quality operating system for selecting and assigning members of technology group project assignments for a desired product to ensure that the manufacturing project is completed in a timely and efficient manner.

As per claims **11** and **18**, Frye discloses:

- changing a project management application graphical interface, as a function of the project assessment (paragraphs 0033 and 0034).

As per claims **12** and **19**, Frye discloses:

- assigning a time limit (milestones, dates, etc.) in association with the project assessment and the project readiness (paragraph 0025).

As per claims **13** and **20**, Frye discloses:

- providing a collaborative environment for the decision maker (paragraph 0031).

As per claims **14** and **21**, Frye discloses wherein the determination of at least one decision maker further comprises:

- providing project information from a project creator; accessing a data repository; retrieving a list from the data repository; selecting a project decision maker as a function of the project information and list; and selecting at least one contributing decision maker as a function of the project information, list, and project decision maker (paragraphs 0031 and 0040, Frye discloses different stage approvers to review and decide whether the program (project) is ready to advance to the next stage).

As per claims **15** and **22**, Frye discloses:

- providing technical information from the project creator (paragraph 0030); and
- providing security information from the project creator (paragraph 0033).

(10) Response to Argument

Appellant argues in substance that:

(a) Claim 1 recites "electronic forum determining a readiness category for the decision

maker" therefore satisfying the prerequisites set forth in *In re Bilski*.

In response, Appellant's argument has been fully considered but is not persuasive. Applicants' amendment to claim does not satisfy the prerequisites set forth in *In re Bilski* because the electronic forum is not hardware but instead software. The Examiner suggested to the applicants' representative that the claims needed to recite some type of hardware performing the recited steps. The Examiner referred applicants' representative to page 4, lines 14-31 and page 5 of the specification, which specifically states a projector creator using a communication device performing these steps. The applicants' representative did not want to add the communication device to claims but however wanted to focus more on the collaborative mechanism which is referred in the specification as an electronic forum as performing theses steps. Applicants' representative was advised that the electronic forum is not hardware and is not used to perform these steps according the pages listed above in the specification.

(b) Frye in view of Helzerman and in further view of Gauger does not teach, and in fact teaches away from the claimed terms "determining a readiness category for the decision maker" and "providing a readiness category rating for the readiness category" as recited in claims 1, 9 and 16 [Appeal Brief pages 12-14].

In response, Appellant's argument has been fully considered but is not persuasive.

Appellants contend that Helzerman does not teach the claimed terms "determining a readiness category for the decision maker" and "providing a readiness category rating for the readiness category" as recited in claims 1, 9 and 16. According to Appellants specification page 7, lines 5-7, the decision maker may select, edit, create and approve the various readiness category after the collaborative building of the readiness categories with their rating levels.

Also, on page 7, lines 19-25 of Appellants' specification, the project decision maker assign one or more readiness categories to each contributing decision maker. However, the Examiner interprets "determining a readiness category for the decision maker" as determining the readiness category of project for the decision maker's use and "providing a readiness category rating for the readiness category" as providing a number to show that the first phase of the project is complete and read for the next phase.

In the prior art Helzerman teaches a quality operating system and method for performing manufacturing projects in which the project is divided into five phases (i.e. concept proposal, concept feasibility, a manufacturing concept ready, manufacturing concept ready, manufacturing implementation ready and replication). The project leaders are selected for managing the project and ensuring that the project is ready before moving to the next phase of the project. The project leaders also conduct milestone reviews to review the project status to ensure the project is progressing according to the project plan (abstract, col. 3, lines 44-62, col. 4, lines 41-64, col. 5, lines 66-67, col. 6, lines 1-12 and col. 9, lines 44-64). Since Helzerman teaches project leaders are selected for managing the project, which may include making decisions, determining if the project is ready to begin and setting milestones for each phase of the project then Helzerman teaches determining a readiness category for the decision maker and providing a readiness category rating for the readiness category as recited in claims 1, 9 and 16.

While the combined system of Frye and Helzerman substantially discloses a method for automated project accountability, it does not explicitly disclose an electronic forum. Nonetheless, an electronic forum is well known in the art as evidence by Gauger. Gauger discloses a network based interactive project management apparatus and method comprising an

electronic forum (paragraphs 0196-0198, Gauger discloses a collaboration center which is used by key individuals to hold meetings, solve team problems and allow threaded discussions). Thus it would have bee obvious to one of ordinary skill in the art at the time the invention was made to modify Frye in view of Helzerman to incorporate or implement an electronic forum for the purpose of allowing key individuals of a project to discuss and solve problems. Therefore, Frye, Helzerman and Gauger teaches "determining a readiness category for the decision maker" and "providing a readiness category rating for the readiness category" as recited in claims 1, 9 and 16.

(c) Frye in view of Helzerman does not teach or suggest "assigning vote weighting to the decision maker as recited in claims 2, 10 and 17 [Appeal Brief pages 15-22].

In response, Applicant's argument has been fully considered but is not persuasive.

Appellants contend that Helzerman does not teach or suggest "assigning vote weighting" to the decision maker as recited in claims 2, 10 and 17. According to Appellants' specification page 7, lines 11-16, a project decision maker designates a decision process by assigning vote weighting to each contributing and participant decision maker in which the decision process may include options as unanimous, simple majority, percentage majority, points system, super voter and other options and rules. The Examiner interprets assigning vote weighting as giving the participants working on the project the authority to make decisions according to their position held during the project.

Helzerman teaches a quality operating system and method for performing manufacturing projects in which the project is divided into five phases (i.e. concept proposal, concept feasibility, a manufacturing concept ready, manufacturing concept ready, manufacturing

implementation ready and replication). The project leaders are selected for managing the project and ensuring that the project is ready before moving to the next phase of the project. The project leaders also conduct milestone reviews to review the project status to ensure the project is progressing according to the project plan (abstract, col. 3, lines 44-62, col. 4, lines 41-64, col. 5, lines 66-67, col. 6, lines 1-12 and col. 9, lines 44-64). Since Helzerman teaches project leaders are selected for managing the project, which may include making decisions, determining if the project is ready to begin and setting milestones for each phase of the project then Helzerman teaches assigning vote weighting to the decision maker as recited in claims 2, 10 and 17.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/LaShonda T Jacobs/

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